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September 11, 2006

RECEIVER: EXAMINER LIVERSEDGE, Jennifer L.
Group Art Unit 3628**FAX #:** 1-571-273-8300 Central Fax**SENDER:** Jonathan O. Scott, Reg. 39,364**Fax# (612) 825-6304**
Telephone: (612) 252-3330**Pages Including Cover Sheet(s):** 7**RE:** Application No. 09/359,083
Docket No.: VISAP016**MESSAGE:** Attached please find the following documents for filing in the
above-referenced application:

- 1) Pre-Appeal Brief Request for Review (4pgs)
- 2) Notice of Appeal (2pgs)

CONFIDENTIALITY NOTE

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: DAVIS et al.

Attorney Docket No.: VISAP016

Application No.: 09/359,083

Examiner: LIVERSEDGE, Jennifer L.

Filed: July 22, 1999

Group: 3628

**RECEIVED
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AUTHENTICATION AND LOADING SYSTEM
USING VIRTUAL SMART CARD**SEP 11 2006**

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being transmitted to the U.S.
Patent and Trademark Office, Central Facsimile Telephone number (571) 273-8300 on
this day September 11, 2006 addressed to Examiner LIVERSEDGE, Jennifer L.

Signed: _____

Ann Lowe

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant requests review of the final rejection in the above-identified application. No
amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reasons stated below.

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REMARKS

Status of Application

The office action mailed December 22, 2005 rejected claims 1-8 and 34-43 under 35 USC §102(e) as being anticipated by U.S. Patent No. 6,282,522 issued to *Davis et al. (Davis)*. Applicant mailed a reply on March 22, 2006 arguing *inter alia* that *Davis* does not teach or suggest "a smart card emulator" nor "a pseudo card reader module" as required by claim 1. The final office action mailed May 9, 2006 repeated the rejection from the earlier office action and presented a "Response to Arguments" on page 9. It is the "Response to Arguments" that forms the basis for this request for review.

I. The Final Office Action Uses a Standard for Anticipation That Is Not Legally Correct.

Applicant's reply asserted that a "smart card emulator" is not taught or suggested in *Davis* because there is no enabling description of a "smart card emulator" in *Davis*. In response, the final office action stated more or less that any disclosure in a reference may serve as anticipatory prior art (final action, page 9). Applicant strenuously disagrees that any disclosure in a reference can serve as a basis for anticipation and asserts that the standard is that disclosure in a reference must be enabling in order to be anticipatory.

The MPEP states that "the standard test is whether a reference contains an enabling disclosure," and that "mere naming or description of the subject matter is insufficient, if it cannot be produced without undue experimentation." (See MPEP 2121.01.)

More importantly, case law supports applicant's position. In order to support a rejection under §102 or §103, a prior art reference must be enabling:

Patented inventions cannot be superseded by the mere introduction of a foreign publication of the kind, though of prior date, unless the description and drawings contain and exhibit a substantial representation of the patented improvement, in such full, clear, and exact terms as to enable any person skilled in the art or science to which it appertains, to make, construct, and practice the invention to the same practical extent as they would be enabled to do if the information was derived from a prior patent. Mere vague and general representations will not support such a defence, as the knowledge supposed to be derived from the publication must be sufficient to enable those skilled in the art or science to understand the nature and operation of the invention, and to carry it into practical use. Whatever may be the particular circumstances under which the publication

takes place, the account published, to be of any effect to support such a defence, must be an account of a complete and operative invention capable of being put into practical operation.

(*Seymour v. Osbourne*, 78 U.S. 516, 555 (1870).

Further, the knowledge possessed by one skilled in the art is taken together with the disclosure of the reference to determine if the public has been placed in possession of the invention on which a patent is sought. *In re LeGrice*, 133 USPQ 365, 371-376 (CCPA 1962), (quoting *Seymour* and citing patent treatises).

In the present situation the requirement that a description be enabling is important because Applicant is asserting that a single phrase that mentions a "virtual smart card" in *Davis* is not enabling and thus cannot anticipate the element of "a smart card emulator" as required by claim 1 (see Applicant's Reply, pages 6-7). This single phrase cannot enable a concept as complex as emulation of a smart card in software. Because the final office action has used a legally incorrect standard for anticipation, it is requested that the final action be withdrawn and that a new action be issued using the correct standard, or that a new search be performed.

II. The Final Office Action Does Not Allege That a Pseudo Card Reader Module Is Disclosed.

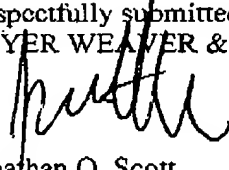
The office action mailed December 22, 2005 alleges that a "pseudo card reader module" is shown in columns 7, 8, 10 and 11 (Office section, page 3). Applicant responded and pointed out very clearly that *Davis* does not disclose a software "pseudo card reader module" as required by claim 1, but rather a physical card reader. The final action, though, did not respond to Applicant's argument regarding this element of claim 1. The final action did repeat verbatim the earlier argument from the first office action, but the "Response to Arguments" at page 9 of the final action did not address Applicant's assertion that a "pseudo card reader module" is not disclosed in *Davis*.

The only conclusion that Applicant can draw is that either the Examiner agrees that a "pseudo card reader module" is not disclosed in *Davis*, or that the Examiner did not fully consider Applicant's reply when drafting the final action. Applicant requests that a new action be issued in which either the Examiner agrees that a "pseudo card reader module" is not

disclosed in *Davis*, or in which the Examiner clearly rebuts Applicant's argument that *Davis* does not disclose a "pseudo card reader module."

Therefore, Applicant requests that the finality of the final office action be withdrawn and that a new non-final office action be issued.

Respectfully submitted,
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